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PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Solohay, Inc.

v.

James Michael Ewing DBA Me So Hungry and Me So Hungry LLC¹

Opposition No. 91199692
to application Serial No. 85133820
filed on September 20, 2010

Michelle R. Hackley of Law Offices of Michelle R. Hackley for Solohay, Inc.

Don Thornburgh of Don Thornburgh Law Corporation for James Michael Ewing
DBA Me So Hungry and Me So Hungry LLC.

Before Kuhlke, Greenbaum and Adlin, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, James Michael Ewing DBA Me So Hungry and Me So Hungry
LLC, seeks registration of the mark ME SO HUNGRY in standard characters for
“catering services,” in International Class 43 on the Principal Register.²

¹ We note the assignment from James Michael Ewing to Me So Hungry LLC executed on February 7, 2013 and recorded with the USPTO at reel/frame 4958/0295. In view thereof, Me So Hungry LLC is joined as party defendant.

Opposer, Solohay, Inc., has opposed registration of applicant's mark on the ground that, as intended to be used with applicant's services, the mark so resembles opposer's previously used mark MISOFISHY for restaurant and bar services, as to be likely to cause confusion under 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). Opposer also pleaded ownership of pending application Serial No. 85267846 for the mark MISOFISHY for, *inter alia*, "restaurant and bar services, including restaurant carryout services" and "restaurant, bar and catering services."

By its answer, applicant denied the salient allegations. Specifically, applicant denies the following allegations:

1. Opposer owns the mark "Misofishy" which registration is currently pending before the United States Patent and Trademark Office (serial number 85267846) and all goodwill of the business connected therewith. Opposer has used the "Misofishy" mark on its restaurant and bar services more than a year prior to Applicant's alleged date of first use of its "Me So Hungry" term.
2. Opposer's first use of the mark "Misofishy" in connection with its restaurant and bar occurred as early as October 27, 2009, when it obtained an Alcoholic Beverage License from the State of California Department of Alcoholic Beverage Control, a Seller's Permit from the State of California State Board of Equalization and opened the "Misofishy" restaurant located at 1928 Lincoln Blvd., Santa Monica, California 90405.

By operation of the Trademark Rules the pleadings herein and the file of the opposed application are of record. Trademark Rule 2.122, 37 C.F.R. § 2.122. In addition, opposer submitted under notices of reliance:

² Serial No. 85133820, filed on September 20, 2010, based on an allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

Opposer's First Requests for Admissions;³

Opposer's First and Second Set of Interrogatories and applicant's responses and amended responses thereto;

Opposer's First Requests for Production of Documents and applicant's responses thereto;⁴

Printouts from various online publications showing the url and date;
and

A "soft" copy of Registration No. 4137062.

Applicant submitted under notice of reliance its untimely responses to Opposer's Requests for Admissions.

As part of its case-in-chief, opposer relies on its Requests for Admission that opposer asserts are deemed admitted pursuant to Fed. R. Civ. P. 36(a)(3) inasmuch as applicant did not timely serve its responses, and objects to applicant's notice of reliance. Applicant, in its notice of reliance, asserts that "[a]s there has been no determination that such requests for admission were deemed admitted, Applicant contends that the fairness rule requires that Applicant's responses be submitted." In its brief, applicant "concedes that such responses were provided to counsel for Opposer 8 days after the statutory deadline." App. Br. p. 5. In addition, applicant

³ Opposer is relying on the Requests for Admission as having been deemed admitted.

⁴ Opposer also submitted under notice of reliance documents that applicant produced in response to these Requests. Absent admissions, documents provided in response to requests for production of documents may not be made of record under notice of reliance; however, the response to the request setting out objections and/or indicating whether or not documents exist may be so introduced. *Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1217 n.8 (TTAB 2011). Because opposer's admission requests do not pertain to the produced documents, the produced documents are not properly of record and cannot be considered.

argues that opposer only relies on Admission No. 14 which states: “Applicant has knowledge that consumer(s) have been actually confused in the belief that “Me So Hungry” is in some way affiliated, connected, associated with, sponsored or approved by Opposer” and this admission is contradicted by applicant’s response to opposer’s Interrogatory No. 17, also made of record by opposer, which reads: “Applicant is unaware of any instance when a person mistakenly made any association, affiliation or connection between Applicant and Opposer or their respective marks or goods or services.” App. Br. p. 6.

There is no dispute that applicant’s responses to the Requests for Admission were late. Therefore, they are deemed admitted by operation of Fed. R. Civ. P. 36(a)(3). Moreover, applicant has not sought to reopen its time to serve its responses or moved to withdraw its admissions.⁵ In view thereof, opposer’s objection is sustained and applicant’s notice of reliance on its proposed responses to the Requests for Admission will be given no consideration. We add, however, that

⁵ “In order to avoid admissions resulting from a failure to respond, a responding party may pursue two separate avenues for relief, namely: a party may either (1) move to reopen its time to serve responses to the outstanding admission requests because its failure to timely respond was the result of excusable neglect under Fed. R. Civ. P. 6(b)(1)(B); or (2) the moving party implicitly acknowledges that the responses are late, deemed admitted, and moves to withdraw and amend its admissions pursuant to Fed. R. Civ. P. 36(b).” TBMP § 525. To the extent we could construe applicant’s comments as a request to withdraw the admissions, it is denied as clearly prejudicial to opposer. Withdrawal of an admission may be permitted “if it would promote the presentation of the merits of the action and if the court is not persuaded that it would prejudice the requesting party in maintaining or defending the action on the merits.” Fed. R. Civ. P. 36(b). In this case, applicant knew its responses were not filed within the time period. In addition, applicant was put on notice in opposer’s notice of reliance that opposer would be relying on the admissions as part of its case-in-chief. At no time did applicant file a motion to withdraw the admissions. While it is preferable to rule on the merits of a case, to withdraw the admissions at the final briefing stage, well after trial is closed, would present a “special difficult[y]” to opposer in proving its case. *Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306, 1308 (TTAB 2007).

the admissions are directly contradicted by applicant's responses to the interrogatories also introduced by opposer, and the Board takes into account and weighs the entire record in making a determination.

We note there are no admissions regarding opposer's ownership or the validity of opposer's pleaded application or any resulting registration, or opposer's first use of the mark MISOFISHY.

STANDING, PRIORITY AND LIKELIHOOD OF CONFUSION

Opposer pleaded its pending application and attached to its notice of reliance a copy of a registration purportedly issued from the pleaded application. Opposer did not, however, submit either a printout from a USPTO database showing the current status and title of this registration, or an "original or photocopy of the registration prepared and issued by the United States Patent and Trademark Office showing both the *current* status and *current* title to the registration."⁶ Trademark Rule 2.122(d)(1) (emphasis added). Therefore, opposer's registration for the mark MISOFISHY is not of record by virtue of the soft copy being submitted under the notice of reliance. *Syngenta Crop. Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1116-17 (TTAB 2009) (copy of the certificate of registration issued by the USPTO is not competent evidence to show the "current status of and current title to the registration"). *See also Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18

⁶ Pledged registrations may be made of record by submitting "a current printout of information from the electronic database records of the USPTO [TARR], showing the current status and title of the registration." Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d). While the attached registration was issued on May 1, 2012, approximately six months prior to its submission under notice of reliance on November 8, 2012, it may not be relied on to prove status and title.

USPQ2d 1710, 1713 (Fed. Cir. 1991); TBMP § 704.03(b)(1)(A) (“Plain copies of the registration are not sufficient.”). We further note the application Serial Number on the copy of the registration is different from the pleaded application Serial Number.⁷ Opposer also asserts the allegation of first use in that registration as proof of its first use. However, even if the registration could support opposer’s assertion of Section 7(b) presumptions, “[t]he allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence.” Trademark Rule 2.122(b)(2). Of course, absent a counterclaim, a properly pleaded and proven registration removes priority as an issue, even where, as in the present case, the filing date of the subject application (September 20, 2010) is earlier than the filing date of the asserted registration (March 15, 2011). However, as noted above there is no registration properly of record upon which we may accord Section 7(b) presumptions to opposer. Opposer could prove priority through testimony; however, opposer did not submit any testimony.

The excerpts from online articles presumably discussing opposer, although admissible for what they show on their face, may not be relied upon for the truth of the matter asserted, i.e., that opposer was using the mark MISOFISHY on the date stamped on the article, as that is hearsay. *Syngenta Crop.*, 90 USPQ2d at 1117 n.7 (printed publications made of record by notice of reliance are admissible and probative only for what they show on their face, not for the truth of the matters

⁷ Without evidence to explain this difference, we could not *sua sponte* amend the pleadings to plead the registration.

contained therein, unless a competent witness has testified to the truth of such matters).

Nor are there any admissions upon which opposer may rely to establish its ownership of the registration. The admissions regarding applicant's knowledge of a Mr. Steve Ki Choi and that "Applicant had knowledge of a restaurant with the name 'Misofishy' operating in the Santa Monica area prior to commencement of Applicant's use of the 'Me So Hungry' mark in commerce," are not sufficient to establish that Mr. Choi is connected to opposer or that opposer used the mark with restaurant or catering services at a date prior to applicant's filing date, i.e., applicant's constructive use date. In addition, in response to Interrogatory No. 12 applicant states that it "was unaware of Opposer's use of Opposer's Mark."

Thus, there is nothing in the record to support opposer's statements in its brief that it is the "sole owner and operator of the mark MISOFISHY for restaurant and bar services, including restaurant carryout services and restaurant, bar and catering services" or that opposer "has used the MISOFISHY mark in connection with these goods and services since October 2009."

In view thereof, opposer has not established priority over applicant's filing date. *See King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

For completeness, we address the likelihood of confusion claim. For purposes of this discussion only, we presume that opposer can rely on the soft copy of the recently issued registration.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also, In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). Two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We turn first to a consideration of the services, channels of trade and classes of purchasers. We must make our determinations under these factors based on the services as they are recited in the involved registration and application. *See In re Elbaum*, 211 USPQ 639 (TTAB 1981).

The “catering services” recited in opposer’s registration are identical to applicant’s “catering services” recited in the subject application. Considering the channels of trade and classes of purchasers, because the services are identical and there are no limitations as to channels of trade or classes of purchasers in either the application or opposer’s registration, we must presume that the parties’ services will be offered in the same channels of trade and will be bought by the same classes of purchasers. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). *See also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Genesco Inc. v. Martz*, 66 USPQ2d

1260, 1268 (TTAB 2003) and *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994).

Applicant's arguments regarding the differences in the actual services and channels of trade are not persuasive inasmuch as we must make our determination on the services as identified in the application and registration, neither of which is limited to any particular type of catering services; as such, both the application and registration encompass all types of catering services. *See In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986).

In view of the above, the *du Pont* factors of the similarity of the services, the channels of trade and classes of purchasers favor a finding of likelihood of confusion.

With regard to the conditions of sale, again, because we are bound by the descriptions of services in the application and registration and because the descriptions of services are not restricted as to price or type, the services at issue must include all types of catering services, inexpensive as well as more expensive, and any type of cuisine. We find this factor also favors opposer, or, at a minimum, is neutral.

Opposer argues that "there is evidence that consumers have been confused in the belief that Applicant's mark 'MESOHUNGRY' is in some way affiliated, connected, associated with, sponsored or approved by Opposer's mark 'MISOFISHY.'" Opp. Br. p. 8. As discussed above, the only "evidence" on this factor is applicant's deemed admission. This admission is in direct contradiction to applicant's responses to opposer's interrogatories, stating that applicant was not

aware of any instances of actual confusion. Moreover the admission, by itself, does not provide any context or the extent of any actual confusion. In view thereof, we find this factor to be neutral.

We now consider the similarity or dissimilarity of applicant's mark ME SO HUNGRY and opposer's MISOFISHY mark when compared in their entireties in terms of appearance, sound, connotation and commercial impression, keeping in mind that "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

Opposer, throughout its brief, refers to applicant's mark as MESOHUNGRY, asserts that both parties "present their respective marks as one continuous word" and then compares the marks by noting, *inter alia*, that the first parts MESO and MISO are "phonetically identical and visually very similar." Opp. Br. p. 5. Applicant's applied-for mark is clearly and obviously not one continuous word. While ME SO may be phonetically similar to MISO, the appearance and, more importantly, the connotation is completely different, in that MISO is "a fermented seasoning paste of soybeans, often with rice or barley added, used to flavor soups and sauces,"⁸ and ME SO in the phrase ME SO HUNGRY simply refers to an individual who is hungry. Phonetically opposer's mark could be perceived as having

⁸ Random House Dictionary (2013) retrieved from www.dictionary.com. The Board may take judicial notice of dictionary definitions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006). *See also University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

the double meaning “me so” and “miso,” but the meaning “miso” would not be lost on customers of restaurant and catering services. The last word in applicant’s mark “HUNGRY” is very different from the second half of opposer’s mark “FISHY.” Although both words, when considered in the context of catering services, could be included in the general category of food and eating, they nonetheless have very different meanings. Thus, despite certain similarities between these marks, we find the differences, at least on this record, outweigh the similarities and this factor weighs against likelihood of confusion. Further, because the marks are so different, the *du Pont* factor of the dissimilarities of the marks outweighs the other relevant *du Pont* factors. Thus, we find this factor to be pivotal in that even considering the *du Pont* factors that favor opposer, this factor of the dissimilarities of the marks outweighs the other factors. See *Kellogg Co. v. Pack’em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single *du Pont* factor may not be dispositive”). See also *Genesco Inc. v. Martz*, 66 USPQ2d 1260 (TTAB 2003). In view thereof, we conclude that there is no likelihood of confusion between applicant’s mark ME SO HUNGRY and opposer’s mark MISOFISHY. *In re E.I. du Pont de Nemours & Co.*, 177 USPQ at 567 (“[E]ach [of the thirteen elements] may from case to case play a dominant role”).

In conclusion, because opposer has not established its prior rights or that the marks are similar, opposer has not carried its burden to prove priority and likelihood of confusion.

Decision: The opposition is dismissed.